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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,126	07/09/2004	Stephen Ray Foor	BA9297USPCT	5564
7590 08/20/2008				
David E Heiser E I du Pont de Nemours & Company Legal Patents Wilmington, DE 19898		EXAMINER SASAN, ARADHANA		
		ART UNIT 1615		PAPER NUMBER
		MAIL DATE 08/20/2008		DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/501,126

Applicant(s)

FOOR ET AL.

Examiner

ARADHANA SASAN

Art Unit

1615

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-7, 9, 11 and 17-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, 2, 4-7, 9, 11 and 17-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant has previously elected a particular (b2) compound as recited in claim 5 (famoxadone). This (b2) compound (famoxadone) is found in the prior art (Jordan et al. (Pesticide Science 55: 105-118 (1999)).

Applicant has previously selected a particular N-oxide compound of Formula I or component (a) as recited in claim 17 (2,6-dichloro-N-[[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl]benzamide). Component (a) is found in the prior art reference Moloney (US Patent 6,503,933).

Therefore famoxadone and the benzamide of claim 17 are considered elected by original presentation and any invention elected will be restricted thereto.

Group I is claims 1, 2, 4, 5 and 17. Group I lacks a Special Technical Feature because: the instant composition claim 1 does not present a contribution over the prior art. As disclosed by Moloney in US Patent 6,503,933, component (a) of Formula I of instant claims 1, 18 and 24 is disclosed (Col. 9, Table 1, Compound 21). Famoxadone, the elected compound of component (b2), can be mixed with agricultural protectants (as taught by Berezna in US 6,066,638) and further taught by Jordan et al. (Pesticide Science 55: 105-118 (1999)). Therefore, the combination of component (a) and (b2) would have been obvious to one of ordinary skill in the art over the teachings of Moloney, Berezna and Jordan. As a result, as currently presented, the instant composition claims lack a special technical feature

Group II is claims 1 & 6 which embrace a plethora of different inventions ranging from compositions which contain combinations of famoxadone and the benzamide of claim 17 with from one to 8 additional ingredients. It is not clear from claim 6 whether the claim requires one of or all of (b1) & (b3)-(b9). Applicant is required to specify the particular combination.

Group III is claims 1, 6 & 7 which restricts the additional component to one or more than one of (b1), (b3), (b6), (b7) (b8) or (b9). As with Group II the applicant must specify the particular combination elected.

Group IV is claims 18-20 directed to a composition comprising famoxadone and the benzamide of claim 17.

Group V is claims 18-21 wherein an additional component is selected from the Markush group of claim 21.

Group VI is claims 18 and 22, directed to compositions comprising an additional component selected from the Markush group of claim 22.

Group VII is claims 18 and 23 directed to compositions which contain combinations of famoxadone and the benzamide of claim 17 with from one to 8 additional ingredients. It is not clear from claim 6 whether the claim requires one of or all of (b1) & (b3)-(b9). Applicant is required to specify the particular combination.

Group VIII is claims 24 & 25 which is directed to a composition comprising famoxadone and the benzamide of claim 17.

Group IX is claims 24 and 26 which is directed to a plethora of different inventions ranging from compositions which contain combinations of famoxadone and the benzamide of claim 17 with from one to 8 additional ingredients. It is not clear from claim 26 whether the claim requires one of or all of (b1) & (b3)-(b9). Applicant is required to specify the particular combination.

Claims 9 and 11 will be examined with which ever group is elected from Groups I-III.

Claims 27 and 28 will be examined with which ever group is elected from Groups IV-IX.

Restriction is required under 35 U.S.C. 121 and 372.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

As set forth in Rule 13.1 of the Patent Cooperation Treaty (PCT), "the international application shall relate to one invention only or to a group of inventions." Moreover, as stated in Rule 13.2 PCT, Unity of Invention is satisfied "where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art so linked as to form a single general inventive concept." The examiner respectfully submits that, as presented, the instant composition claim 1 does not present a contribution over the prior art. As disclosed by Moloney in US Patent 6,503,933, component (a) of Formula I of instant claims 1, 18 and 24 is disclosed (Col. 9, Table 1, Compound 21). Famoxadone, the elected compound of component (b2), can be mixed with agricultural protectants (as taught by Berezna in US 6,066,638) and further taught by Jordan et al. (Pesticide Science 55: 105-118 (1999)). Therefore, the combination of component (a) and (b2) would have been obvious to one of ordinary skill in the art over the teachings of Moloney, Berezna and Jordan. As a result, as currently presented, the instant composition claims lack a special technical feature and, as such, unity between the above Groups I – VI is broken.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aradhana Sasan whose telephone number is (571) 272-9022. The examiner can normally be reached Monday to Thursday from 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Aradhana Sasan/
Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615